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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/564,547

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Patrick Schiffrine

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02/03/2011

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EXAMINER

FISHER, ELANA BETH

ART UNIT

PAPER NUMBER

3733

NOTIFICATION DATE

DELIVERY MODE

02/03/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

Office Action Summary	Application No. 10/564,547	Applicant(s) SCHIFRINE ET AL.	
	Examiner ELANA B. FISHER	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8 and 19-28 is/are pending in the application.
- 4a) Of the above claim(s) 27 and 28 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 3-8 is/are allowed.
- 6) ☒ Claim(s) 19,22,23 and 26 is/are rejected.
- 7) ☒ Claim(s) 20,21,24 and 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/14/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. It is noted that claims 19-26 are being examined in view of 35 U.S.C. 112, 6th paragraph.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 10, 2010 has been entered.

Election/Restrictions

3. Newly submitted claims 27-28 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 1, 3-8, and 19-26 are directed to a device and claims 27-28 are directed to a method. The method in claims 27-28 can be performed with a device for positioning a total knee prosthesis that is structurally/materially different than the device claimed in claim 19, such as a device without a base mounting element and with a tibial plate that is structurally different than the means for providing support disclosed in the specification.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 27-28 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 23 recites the limitation "tibial plate" in the twenty-first and twenty-third lines of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

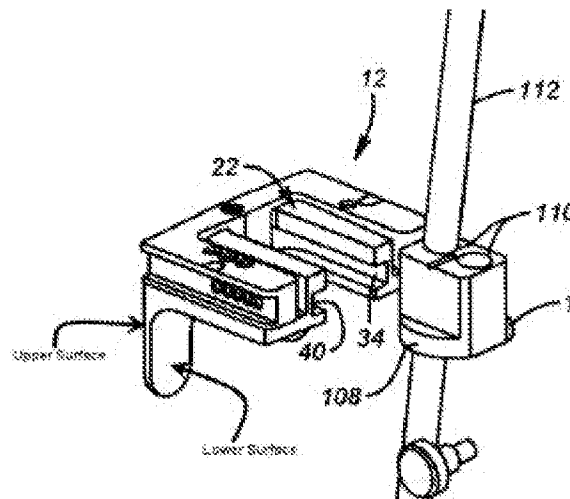
6. Claims 19, 22-23 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Burkinshaw et al. (U.S. Patent 6,290,704).

Claims 19 and 22:

Burkinshaw et al. disclose a device for positioning a total knee prosthesis, comprising: a medullary rod (112) having a proximal end, the medullary rod configured to be introduced into a femoral medullary canal; a rod base (14) attached to the proximal end of the medullary rod, the rod base having i) a face (bottom of 14; FIG 1) configured to contact the femoral condyles when the medullary rod is disposed within the femoral medullary canal, and ii) a base mounting element (106, 108); a means for providing support (26) on an upper surface of a tibial cut; and a displacement element (28) comprising a distal end extending from the means for providing support and being attachable to the base mounting element such that the medullary rod (112) is approximately parallel to the upper surface (see diagram provided) of the means for providing support, wherein the displacement element (28) is operable to displace the means for providing support (26) bearing on an upper surface of the tibia with respect to the rod base (14).

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The displacement element (28) comprises a slide housing (12) extending from the upper surface of the means for providing support (26) and a slide (34, 40) displaceable on the slide housing. The rod base (14) mounts to the slide (34, 40), and the rod base (14) when mounted on the slide is positioned approximately perpendicular with the upper surface of the means for providing support (FIG 1).



Claims 23 and 26:

Burkinshaw et al. disclose a device for displacing a tibia and a femur, the tibia having a tibial axis and a cut proximal surface, and the femur having a femoral medullary canal, comprising: an ancillary component comprising a medullary rod (112) and an attachment part (14) attached at a proximal end of the medullary rod, the medullary rod configured to be introduced into the femoral medullary canal; a tensioning device comprising: i) means for providing support (26) on an uppermost surface of the cut tibia, ii) a first component (28) that is attached at one end to the supporting means, and iii) a second component (106,108) that is attached to the attachment part (14) of the ancillary

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component, wherein, the first component and the second component are movable with respect to one another so as to displace the supporting means (26) between i) a first position wherein the medullary rod (112) and means for providing support (26) are separated by a first distance as measured along the tibial axis, and ii) a second position wherein the medullary rod (112) and means for providing support (26) are separated by a second distance as measured along the tibial axis, the second distance being greater than the first distance (FIG 1). The first component (28) comprises a slide housing (34, 40) and the second component (106, 108) is a slide, with the slide being configured to slide with respect to the slide housing (FIG 1).

Allowable Subject Matter

7. Claims 1 and 3-8 are allowed.
8. Claims 20-21 and 24-25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

9. Applicant's arguments filed May 10, 2010 have been fully considered but they are not persuasive.

Examiner has considered applicant's arguments, however respectfully disagrees. Applicant argues that by amending the claims to replace "means for providing support" as opposed to "tibial plate", then the amendments overcome the rejection. Applicant's remarks state that since "means for providing support" invokes 35 U.S.C. 112, 6th paragraph, then examiner must give consideration to the structure disclosed in the

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specification and equivalents thereof. Applicant only points to one difference in structure between the means for providing support in the Burkinshaw reference and applicant's reference: that the lower surface in Burkinshaw is not planar like that of applicant's. However, examiner disagrees with this difference. As shown in the diagram on page 3 of this office action, the lower surface taught by Burkinshaw is also planar.

Additionally, applicant argues that since the Burkinshaw reference is not shown in conjunction with the tibia, then element 26 cannot be the means for support. Examiner disagrees with this as well. There is nothing in the Burkinshaw reference that precludes the device from being used in conjunction with the tibia. Additionally, the examination of the claims in view of 35 U.S.C. 112, 6th paragraph only requires that the structural elements disclosed in the specification be the same or functional equivalents. It does not require examiner to read method of use into the limitation. It merely requires that the element be capable of performing the desired function. Accordingly, examiner maintains the rejection of claims 19, 22-23, and 26 over Burkinshaw et al.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELANA B. FISHER whose telephone number is (571)270-3643. The examiner can normally be reached on Monday through Friday from 8:30AM to 5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571)272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elana B Fisher/

Examiner, Art Unit 3733

/EDUARDO C. ROBERT/

Supervisory Patent Examiner, Art Unit 3733